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In re Application of
SHIM *et al*
U.S. Application No.: 10/550,525
PCT No.: PCT/US2004/009570
Int. Filing Date: 26 March 2004
Priority Date: 27 March 2003
Attorney Docket No.: 050508-1370
For: CXCR4 ANTAGONISTS AND
METHODS OF THEIR USE

DECISION

This is a decision on applicants' "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181(A)" filed 12 May 2008.

BACKGROUND

On 22 September 2005, applicants filed papers to enter the national stage of PCT/US2004/009570 which included a computer readable form (CRF) sequence listing.

On 06 October 2005, the Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors in the sequence listing and sent an error report.

On 11 May 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) requesting an oath or declaration, additional claim fees and a sequence listing. A two-month time period for response was set with extensions of time available.

On 11 August 2006, applicants filed a response which included an executed declaration and a sequence listing.

On 12 October 2006, the STIC again detected errors in the sequence listing and sent an error report.

On 20 November 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed indicating that additional claim fees of \$25.00 a new CRF sequence listing diskette was required. Applicants were given one month to respond, or any time remaining in the Form PCT/DO/EO/905 with extensions, whichever was longer.

On 11 December 2006, applicant purportedly filed a response to the Form PCT/DO/EO/916 mailed 20 November 2006 which included a CRF diskette. This response and CRF diskette are not located in the file.

On 26 February 2007, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the Form PCT/DO/EO/905 mailed 28 February 2002 within the time period set therein.

On 02 March 2007, applicants filed a petition to withdraw the holding of abandonment.

On 13 March 2008, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed as applicant failed to show that a response to the Form PCT/DO/EO/916 mailed 20 November 2006 was submitted.

On 12 May 2008, applicants filed a renewed petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, a copy of a date-stamped postcard receipt for a response purportedly filed 11 December 2006, copies of the documents filed 11 December 2006 along with a CRF sequence listing diskette.

On 10 June 2008, the Patent Electronic Business Center indicated that the sequence listing diskette filed on 12 May 2008 was not accepted.

DISCUSSION

In the renewed petition, applicants' claim that a response to the Notification of a Defective Response (Form PCT/DO/EO/916) mailed 20 November 2006 was provided on 11 December 2006. Applicants also argue that they had no knowledge of the errors in the sequence listing as the Office never provided a copy of the sequence listing error reports and the Form PCT/DO/EO/905 and the Form PCT/DO/EO/916 erroneously noted that "the problem with the sequence listing was that the paper copy and the CRF copy were not the same."

Response Filed 11 December 2006

The response purportedly filed 11 December 2006 was not located in the application. Nonetheless, a postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants provided a copy of the date-stamped postcard receipt for the documents and diskette submitted 11 December 2006. The postcard receipt records that among other papers, applicants included "Statement Re Sequence Listing;

Sequence Listing w/ Diskette." The postcard receipt is stamped "IAP15 Rec'd PCT/PTO 11 DEC 2006" across its face. The U.S. application number, attorney docket number, filing date and applicant were listed on the postcard receipt.

Applicants have provided *prima facie* evidence that a response to the Form PCT/DO/EO/916 was originally received by the USPTO on 11 December 2006.

Sequence Listing Defects Not Known

Applicants claim that they never received a copy of any sequence listing error reports until the prior decision. In addition, both the Form PCT/DO/EO/905 mailed 11 May 2006 and the Form PCT/DO/EO/916 mailed 20 November 2006 did not provide any notice of the defects with the CRF diskettes.

A review of the Form PCT/DO/EO/905 and the Form PCT/DO/EO/916 show that they both noted that the problem with the CRF sequence listing was that the paper copy was not the same as the computer readable form of the sequence listing. That was incorrect. There is also no evidence that any sequence listing error reports were provided to applicants.

For these reasons, the Form PCT/DO/EO/905 mailed 11 May 2006 and the Form PCT/DO/EO/916 mailed 20 November 2006 are both **VACATED**.

DECISION

Applicants' renewed petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 26 February 2007 is hereby **VACATED**.

Applicants included a substitute CRF sequence listing with the renewed petition "which corrects the errors identified in the STIC error report of October 6, 2005." However, the CRF sequence listing has still not been accepted by the Patent Electronic Business Center. A copy of their error report will be mailed with this decision.

Applicants have **TWO (2) MONTHS** to provide an acceptable CRF sequence listing diskette. Extensions of time under 37 CFR 1.136(a) are available.

Failure to submit an acceptable sequence listing in the time period given will result in the abandonment of this application.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to the number listed below, or if mailed

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addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Atch.: Patent Business Center Sequence Listing Error Report (10 June 2008)